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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,925	05/04/2001	Jean-Marc Villaret	10005203-1	8953

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/849,925

Applicant(s)

VILLARET ET AL.

Examiner

James S McClellan

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-14 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-14 and 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Amendment

1. Applicant's submittal of an amendment was entered on June 21, 2004, wherein:
 - claims 1, 3-14, and 16-19 are pending;
 - claims 2, 15, and 20-22 have been canceled; and
 - claims 1, 7-12, 16, 17, and 19 have been amended.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-7, 11-14, 16, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkins et al.

Jenkins et al. disclose a system a system and method for providing products via an EFTPOS terminal arrangement (see col. 11, lines 18-29) coupled to a plurality of vendor DPSs (150) hosting both payment and non-payment application (see, for example, Fig. 4 and col. 11, lines 18-29) and coupled to a financial institution DPS hosting a second application (see col. 11, lines 18-29, comprising: accessing the first application at the first vendor's DPS via the non-payment application (see col. 6, lines 24-33); selecting a product via the non-payment application (see col. 6, lines 44-48); transmitting a set of customer-specific financial account data

Art Unit: 3627

to the second application on the financial institution DPS (see col. 11, lines 18-29); and receiving a transaction confirmation status (see col. 6, line 66 through col. 7, line 4). Jenkins et al. further disclose the step of displaying an electronic message received from one of the vendor DPSs (see col. 6, lines 24-30). Jenkins et al. further disclose a product database that includes a data set identifying a payment amount (see for example, col. 8, lines 27-41) and the step of transmitting the data set to a second vendor DPS in response to receiving transaction confirmation.

Jenkins et al. discloses all of the limitations of the claims except for the steps of providing advertisements from the vendor or other real-time messages.

However, advertisements and real-time messages are common in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ advertisements and real-time messages with the invention of Jenkins et al. to generate interest among potential customers.

White et al. is cited as factual evidence to support the Examiner's assertion of Official Notice. White et al. discloses a transaction terminal that includes an ad area (78) for displaying advertisement content that may be static, dynamic, and/or interactive (col. 8, lines 18-28).

4. Claims 3 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkins et al. as applied to claim 1 and 12 above, and further in view of Bertina et al.

Jenkins et al. disclose all of the limitations of the claims except for the step of wirelessly communicating with the EFTPOS terminal.

Bertina et al. disclose a system for wirelessly communicating with an EFTPOS terminal (see col. 2, lines 5-18).

Art Unit: 3627

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Jenkins et al. with the teachings of Bertina et al., because wireless communication is more convenient.

5. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkins et al. in view of U.S. Patent No. 6,000,608 (hereinafter "Dorf").

Jenkins et al. discloses all the claimed elements set forth above but fails to explicitly disclose storing the stored-value data set in an information storage card by the EFTPOS terminal arrangement.

Dorf teaches the use of storing the stored-value data set in an information storage card by the EFTPOS terminal arrangement (see column 4, lines 14-35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Jenkins et al. with the stored value card as taught by Dorf, because storing information on a stored value card allows the stored information to be available for access from POS terminals without the cumbersome need for the POS to have permanent access to the same information stored in a separate database.

Response to Arguments

6. Applicant's arguments filed June 21, 2004 have been fully considered but they are not persuasive.

On page 8, final paragraph, Applicant's arguments regarding claims 8, 9, and 10 are moot in view of the new grounds of rejection required by Applicant's amendment.

Art Unit: 3627

On page 9, paragraphs 1-3, Applicant argues that Jenkins fails to disclose all the limitations of claims 15 and 17. The Examiner has supplied factual evidence (White et al.) to support the assertion of Official Notice.

On page 9, fourth paragraph, Applicant argues that the alleged motivation uses the limitations of the present claims to supply the motivation. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is to generate interest among potential customers. The Examiner is unaware of the motivation being a limitation in the present claims.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 3627

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

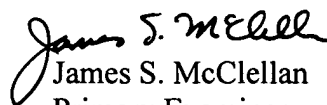
Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

or faxed to:

(703) 872-9306 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.


James S. McClellan
Primary Examiner
A.U. 3627

jsm
September 24, 2004